

## **REMARKS**

Claims 1-24 and 34-36 were examined and rejected. Applicant amends claims 8 and 20; adds no claims; and cancels no claims. Applicant asserts that no new matter is added herein and that an additional search is not necessary as amendments to claims 8 and 20 are to cure a typographical omission of the term "a" before the term "size". Applicant respectfully requests reconsideration of claims 1-24 and 34-36 as amended in view of at least the following remarks.

### **I. Claims Rejected Under 35 USC § 112**

The Patent Office rejects claims 1-7 and 34 under 35 USC § 112, first paragraph as failing to comply with the written description requirement because it appears that the original specification does not have support for "a generally planar surface and one of conductive pads and trace pads surrounding the generally planar surface such that the generally planer surface is accessible to a pick-and-place adapted to be attached to via a vacuum force attachment" as claimed in claim 1.

Applicants respectfully disagree since amended claim 1 is supported by the specification as originally filed as described above (e.g., for example, without limitation thereto, see at least paragraphs 9, 15, 17, 19, 28-29, and 31; and figures 1-4 of the Application as originally filed). The specification and figures, as filed, describe and show various embodiments of energy conduits 122-124. For example, in some embodiments, energy conduits 122-124 may include electrical contacts, active electronic devices, and/or electrical signal traces (see paragraph 17 lines 9-16). Also, energy conduits 122-124 may be formed of or include a trace pad (see paragraph 19 lines 1-4) and/or a conductive pad (see paragraph 19 lines 5-8). Applicant notes that Applicant's prior reference to paragraph 23 was erroneous as that paragraph describes contacts 182. Also, in some cases, energy conduit devices 142-144 may be part of energy conduits 122-124 (see paragraph 25 lines 7-8). More specifically, in some cases, devices 142-144 may be described as contacts, such as where conduits 122-124 have contacts 142-144 (see

paragraph 29 lines 5-6). Thus, conduits 122-124 may be formed of or include trace pads or conductive pads (see paragraph 19). However, the Patent Office's interpretation that "it appears that the conductive pads and trace pads are different from the energy conduit devices" (see item 2 of the current Office Action) is inaccurate. First, claim 1 does not claim "energy conduit devices," but claims "energy conduits" (e.g., conduits 122-124). Moreover, as noted above, those conduits may be formed of or include conductive pads or trace pads. For instance, in some embodiments, the conductive pad or trace pad of an energy conduit may be in the form of a contact, such as contacts 142-144 shown in Fig. 3 and described in paragraph 29. It is noted that descriptions above provide examples of claim terms, without limitation thereto.

Any dependent claims not mentioned above are submitted as complying with the written description requirement, for at least the same reasons given above in support of their base claims. Hence, Applicants respectfully request the Patent Office withdraw the rejection above.

### **III. Claims Objected To**

The Patent Office objects to claims 1-4, 8-19, 20-24 and 34-36 because of informalities. Specifically, Patent Office objects:

For claim 1, the Patent Office states that "it is unclear how the conductive pads and trace pads are associated and interrelated with the energy conduits or energy conduit devices (142-144)." Applicant respectfully disagrees. An argument analogous to the one above with respect to claim 1 and the written description requirement applies here as well.

Thus, conductive pads and trace pads may be an example of an energy conduit device (e.g., 142-144) and/or a contact (e.g., 142-144) which may form or be part of the claimed energy conduits (e.g., 122-124). Hence, for at least this reason, Applicant respectfully requests the Patent Office withdraw the objection above to claim 1.

For claims 8 and 20 “it is unclear which part of apparatus having a size that is smaller or equal in depth as compared to a depth of an inner dimension of the cavity.” Again, the specification and figures, as filed, give various examples of embodiments having a size as noted above for claim 8. For example, without limitation thereto, the size referred to above may be a total maximum size of the apparatus in height or thickness, such as extending from the topmost surface of first side 148 or energy conduit device 142 to a bottommost surface of second side 118 or stimuli transfer zone 112 (see fig. 2) such that retainer 170 may close over apparatus 110 (see figs. 1-2).

Moreover, Applicants point out that for example, without limitation thereto, in amended claims 8 and 20 (using claim 8 as representative of claims 8 and 20) “the apparatus having a size that is smaller or equal in depth as compared to a depth of an inner dimension of the cavity” may refer to the size of energy conduit 122 of apparatus 110 having a depth (a depth including a depth of energy conduit device 142, thickness T, and stimuli transfer zone 112, as shown in the vertical direction of Fig. 2 of Applicants’ specification) that is smaller or equal in depth (in the vertical direction of Fig. 2 of Applicants’ specification) as compared to a depth of an inner dimension of socket cavity 136 of socket 130 (a depth of socket 130 above socket contact 132 and below the portion of retainer 170 contacting socket 130, as shown in the vertical direction of Fig. 2 of Applicants’ specification).

Applicants point out that the example above is not limiting, as various other depths that satisfy the feature “apparatus having a size that is smaller or equal in depth as compared to a depth of an inner dimension of the cavity” may also be appropriate, such as those described and/or shown in various examples in the specification, claims and figures of the Application, as originally filed (see paragraphs 9, 10, 13-14, 30-31, and 34-35; and shown in figures 1-4), without limitation thereto. Specifically, in another example, without limitation thereto, in amended claims 8 and 20 “the apparatus having a size that is smaller or equal in depth as compared to a depth of an inner dimension of the cavity” may refer to the maximum depth of apparatus 110 (including energy

conduits 122-124, energy conduit devices 142-144, thickness T between first side 148 and second side 118, and stimuli transfer zones 112-114, as shown in the vertical direction of Fig. 2 of Applicants' specification) that does not extend above the upper surface of the walls of socket 130, and thus does not prohibit retainer 170 from being locked over apparatus 110 within socket 130 by lock 139 as shown in Figures 1 and 2. Hence, for at least the reasons explained above, Applicant respectfully requests the Patent Office withdraw the objection above of claims 8 and 20.

For claim 12 "it is unclear what 'a plurality of contacts' comprises of." Applicants point out that upon actually reading line 10 of paragraph 17 of the Application, a practitioner in the arts would find clear that the energy conduits may include electrical contacts. Specifically, without limitation thereto, the contacts of claim 12 may be represented by stimuli transfer zones 112-114 as shown in fig. 2 (which may be part of energy conduits 122-124 as described in paragraph 16 lines 1-7), which may form electrical contacts (see paragraph 17 lines 6-10) which may form electrical contact to or be electrically attached to contacts 132-134 of socket 130 (see paragraph 17 lines 6-9). Hence, for at least the reasons explained above, Applicant respectfully requests the Patent Office withdraw the objection above of claim 12.

Any dependent claims not mentioned above are submitted as being definite and clear, for at least the same reasons given above in support of their base claims. Hence, Applicant respectfully requests the Patent Office withdraw the rejection above.

#### **IV. Claims Rejected Under 35 U.S.C. § 102**

The Patent Office rejects claims 1-7 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,436,570 to Tan (Tan). It is axiomatic that for a claim to be anticipated, every limitation of that claim must be disclosed in a single reference.

Applicants respectfully disagree with the rejection above and submit that independent claim 1 is patentable over the cited reference for at least the reason that the cited reference does not teach or suggest a first side including a generally planar surface

and one of conductive pads and trace pads surrounding the generally planar surface such that the generally planer surface is accessible to a pick-and-place vacuum force attachments, as required by claim 1.

Tan describes a test probe having a test body 20 and test head 22 comprising printed circuit board wall 2, each having a plurality of stainless steel pins 15 embedded therein to contact socket pins of an IC socket (see Abstract; and col. 2, lines 48 through col. 3, lines 20). On the other end of test body 20, Tan teaches ends of test terminals 4 extending well above testing end 5 for accommodating cable connection headers 10 which attach to the (see Figures 1 and 3; and col. 3, lines 40-52). Specifically, Tan teaches testing end 5 of probe body 20 comprising a plurality of slots 23 for accommodating cable connection headers 10 (see col. 3, lines 40-52). Thus, each of headers 10 is attached to 18 of test terminals 4 (see col. 3, line 50 and Figures 1 and 3).

Consequently, the Patent Office has not identified and Applicants are unable to find any teaching or suggestion of a generally planar surface and one of conductive pads and trace pads surrounding the generally planar surface as required by claim 1. Instead, Tan teaches 18 test terminals 4 extending, which are clearly not conductive pads or trace pads, but instead extend a distance above end 5 that is many times greater than the width of a terminal, so as to be attached to by header 10 (see col. 3, line 50 and Figures 1 and 3).

Moreover, a practitioner in the art would not be motivated to consider conductive pads and trace pads surrounding a generally planar surface such that the generally planar surface is accessible to a pick-and-place vacuum force attachment, upon consideration of the above described structure of Tan by that practitioner. For instance, according to Tan, first, a test probe is coupled electrically to test equipment; second, an IC device is removed from an IC socket; and then, the test probe takes the place of the IC device in the socket (see col. 1, lines 15-26). Thus, Tan teaches header 10 as the attachment to body 20 (see Tan Fig. 3), but does not teach a planar surface surrounded by conductive pads or trace pads such that the planar surface is accessible,

as required by claim 1. Hence, for at least the reasons above, Applicants respectfully request the Patent Office withdraw the rejection above.

The Patent Office rejects claims 8, 11-15, and 17-24 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,436,570 to Tan (Tan).

Applicants now address from the current Office Action that the “Examiner reads the test device portion as a second side and the second side as a test device portion”. This is inaccurate. For example, claim 8 requires a first side, and a second side disposed opposite the first side and having a dimension suitable to be removably coupled to a socket. To find an example of such a second side, without limitation thereto, the Patent Office is invited to read paragraph 15 of the application as originally filed and fig. 2 which specifies “apparatus 110 having second side 118 having a dimension suitable to be removably coupled to socket 130.” Thus, again, for at least this first reason, the Patent Office’s misinterpretation of claim 8 is inaccurate and unsupported. For example, without limitation thereto, in amended claim 8 “a second side” may be shown by the bottom or second side 118 of apparatus 110, which may include socket contacts 112-114 within test device portion 152 of apparatus 110 as shown in Figs. 2-3 of Applicants’ specification.

Next, Applicants respectfully disagree with the rejection above and submit that independent claims 8 and 20 are patentable over the cited reference for at least the reason that the cited reference does not teach or suggest an apparatus having a size that is smaller or equal in depth as compared to a depth of an inner dimension of the cavity as required by claims 8 and 20.

Tan describes a test probe having a test body 20 and test head 22 comprising printed circuit board wall 2, each having a plurality of stainless steel pins 15 embedded therein to contact socket pins of an IC socket (see Abstract; and col. 2, lines 48 through col. 3, lines 20). However, Tan teaches and clearly shows in Figure 4 that head 22 is much greater in depth than the cavity of socket 21 (e.g., in the vertical direction).

Consequently, the Patent Office has not identified and Applicants are unable to find any teaching or suggestion of the above noted limitations of claims 8 and 20. Hence, for at least the reasons above, Applicants respectfully request the Patent Office withdraw the rejection above.

Applicants submit that any dependent claims being dependent upon allowable base claims are patentable over the cited references for at least the reasons cited above for their base claims. Thus, Applicants respectfully request the Patent Office withdraw the rejection of any dependent claims.

### CONCLUSION

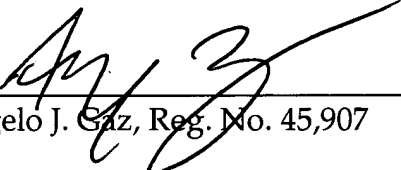
In view of the foregoing, it is believed that all claims now pending patentably define the subject invention over the prior art of record and are in condition for allowance, and such action is earnestly solicited at the earliest possible date.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2666 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17. If a telephone interview would expedite the prosecution of this Application, the Examiner is invited to contact the undersigned at (310) 207-3800.

Respectfully submitted,

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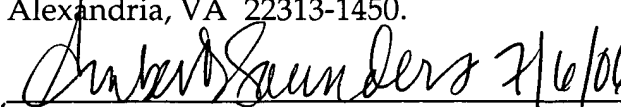
Dated: July 6, 2006

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 7/6/06  
Amber D. Saunders Date